



THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s): Thomas Mark Levergood et al.
Appl. No.: 09/548,235
Filed: April 12, 2000
Title: WEB ADVERTISING METHOD
Art Unit: 2155
Examiner: P. Winder
Docket No.: 113948-026

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Technology Center 2100

Commissioner for Patents
Washington, DC 20231

RESPONSE TO OFFICE ACTION

Sir:

This Response is submitted in response to the Office Action dated March 31, 2003.

The present amendment and remarks are in response to the non-final Office Action entered in the above identified case and mailed on March 31, 2003. According to the Examiner a Supplemental Oath or Declaration is required under 37 CFR §1.67 because the application presents a claim for subject matter not originally claimed or embraced in the statement of the invention. Claims 1-12 are pending. Claims 1, 4-6 and 9-11 were rejected under 35 U.C.S. §112 first paragraph as containing subject matter which was not described in the Specification in a manner sufficient to enable one of ordinary skill in the art to practice the invention. Additionally, claims 1-12 stand rejected under 35 U.S.C. §103 as being unpatentable over Catledge et al., *Characterizing Browsing Strategies In The World Wide Web*, http://www.igd.fhg.de/archive/1995www95...terns/user_patterns.paper4. formatted, in view of Bob Novick, The clickstream, Applicants respectfully traverse.

Applicants turn first to the requirement of a Supplemental Oath or Declaration under 37 CFR §1.67. The present case is a Divisional application based on Serial Number 09/005,479, which in turn is a Continuation of Serial Number 08/474,096, now U.S. Patent No. 5,708,870.

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The disclosure in the present specification is substantially identical to the Parent Application Serial No. 08/474,096.

Page 14, Line 14 of the Description Of The Invention portion of the originally filed specification states:

In one embodiment, the time intervals between repeated requests by a common client are measured to exclude those requests falling within a defined period of time.

Additionally, the server may, at any given time, trace access history within a client-server session. Such a history profile informs the service provider about link transversal frequencies and link paths followed by users. This profile is produced by filtering transaction logs from one or more servers to select only transactions involving a particular user ID (UID). Two subsequent entries, A and B, corresponding to requests from a given user in these logs represent a link traversal from document A to document B made by the user in question. This information may be used to identify the most popular links to a specific page and to suggest where to insert new links to provide more direct access. In another embodiment, the access history is evaluated to determine traversed links leading to a purchase of a product made within commercial pages. This information may be used, for example, to charge for advertising based on the number of link traversal from an advertising page to a product page or based on the count of purchases resulting from a path including the advertisement. In this embodiment, the server can gauge the effectiveness of advertising by measuring the number of sales that resulted from a particular page, link or path of links. The system can be configured to charge the merchant for an advertising page based on the number of sales that resulted from the page.

The subject matter of the claims now pending in the present application can be found nearly verbatim in the above passage. Thus, it cannot be argued that charging for advertising based on link traversals, or evaluating the effectiveness of advertising based on the number of sales resulting from link traversals from a particular advertisement were subject matter substantially embraced by the original statement of the invention. Accordingly, Applicants respectfully

submit that a Supplemental Oath or Declaration according to 37 C.F.R. §1.67 is not required in the present case.

Applicants now turn to the rejection under 35 U.S.C. §112. Claims 1 and 6 stand rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter which is not described in the specification in such a way as to enable one of ordinary skill in the art to make and/or use the invention. Specifically, the Examiner asserts that Applicants have not provided an enabling disclosure of “charging for advertising based on link traversals to the page.” Applicants’ position on this issue is fully presented in Applicants’ previous response. The Examiner has given no indication as to what part of “charging for advertising based on the number of link traversals to the page” is not sufficiently clear to enable one of ordinary skill in the art to practice the invention. Definition for “charging” given in Webster’s New Riverside Dictionary is “4. To ask as a price.” Thus, according to the invention one asks as a price for advertising an amount “based on the link traversals to the pace.” Applicant submits that this phrase is enabling even to those with minimum skill in the art.

Claims 4-5 and 9-11 also stand rejected under 35 U.S.C. § 112, first paragraph. According to the Examiner these claims also contain subject matter which is not described in the specification in such a way as to enable one skilled in the art to make and/or use the invention. Specifically, the Examiner asserts that Applicants have not provided a detailed disclosure of the step of “measuring the number of sales or transactions resulting from link traversals.” Again, the Examiner is mistaken in this assertion. Page 14, line 17 of the specification clearly states that the server may, at any given time, track access history within a client-server session. An history profile is produced by filtering transaction logs from one or more servers to select only transactions involving a particular user ID. These transaction logs include all transactions made

using a particular user ID, including purchasing products. As described at page 14, line 24 of the specification, in an embodiment of the invention the access history is evaluated to determine which links have been traversed leading to the purchase of a product. Applicants are at a loss to determine how the step of “measuring the number of sales (or transactions) resulting from link traversals” could be enabled more fully. On the contrary, Applicants respectfully submit that the subject matter of claims 4-5 and 9-11 is fully enabled in the Specification and that the rejection under 35 U.S.C. § 112, first paragraph should be withdrawn.

Turning now to the rejection based on the prior art, claims 1-12 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Characterizing Browsing Strategies in The World Wide Web* in view of Novick, The clickstream.

Applicants note that in order to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the reference themselves or within the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. *In re Fine*, 837 F.2d 1071, 5, USPQ2d 1596 (Fed. Cir. 1988). Second, there must be a reasonable expectation of success. *In re Merck & Co., Inc.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Finally, all of the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ, 580 (CCPA 1974). In this respect, “[o]bviousness cannot be established by combining the teaching of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination.” *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 221 U.S.P.Q.2d 929, 932 (Fed. Cir. 1984).

The claimed invention is not obvious over the combined teaching of Catledge et al. and Novick for at least two reasons. First, there is no teaching or suggestion within the references

themselves or within the knowledge generally available to those skilled in the art that would have led one of ordinary skill in the art to make the combination suggested by the Examiner. Second, even when combined, Catledge et al. and Dedrick do not teach or suggest every element of the claimed invention.

The Examiner asserts that it would have been obvious for one of ordinary skill in the art at the time of the present invention to modify the Catledge et al. study of browsing strategies to incorporate the feature of charging for advertising as taught by Dedrick. Catledge et al. describe a study that captured client-side user events during web browsing sessions using a web browser. *See*, Catledge et al., Abstract. Catledge et al. further disclose that the information captured during the study provides design and usability suggestions for web pages, web sites and browsers. Catledge et al. make no reference to the desirability of advertising on a web page or web site, nor do they make any reference to charging for advertising placed on the web, and especially not to charging for advertising based on link traversals to a web page.

The Examiner cites Novick for teaching the feature of charging for advertising based on the number of link traversals from a first document to a second document, when in fact all that Novick discloses is that that advertisers are advertising on the Web, and that in the future we may hear about "the cost per thousand clicks". The Examiner points to no specific teaching in either Catledge or Novick that would have suggested combining Novick's advertising concepts with Catledge's study on internet usage patterns. There simply is no suggestion or motivation in the references themselves that supports the combination made by the Examiner. Because there is no teaching or suggestion to combine within the references themselves or within the general knowledge of those skilled in the art, the Examiner has failed to establish a *prima facie* case of obviousness under 35 U.S.C. §103 and claims 1-12 must be allowed.

Furthermore, even if one of ordinary skill in the art would have been motivated to combine the teachings of Catledge et al. with that of Novick as suggested by the Examiner, the resulting combination does not teach or suggest every element of the claimed invention. Novick only suggests the "cost per thousand clicks". The cost of what? What is being clicked? Novick does not teach tracking link traversals and charging for advertising based on the number of link traversals to a page.

Similarly, Novick also fails to teach or suggest the step of measuring the number of sales or transactions resulting from link traversals from an advertisement to a second page as required by claims 4 and 5. Novick is silent regarding monitoring the number of sales or transactions which result from the end user's traversing a specified link. Thus, since Novick et al. does not teach or suggest charging for advertising based on link traversals to a page or measuring the number of sales or transactions resulting from link traversals from the advertising page, the Examiner has again failed to establish *prima facie* obviousness with regard to claims 4 and 5 and the rejection of these claims under 35 U.S.C. §103 should also be withdrawn.

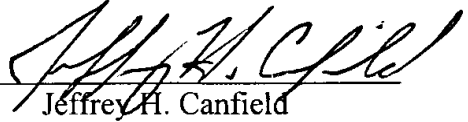
In light of the present amendment to the specification and the preceding remarks, Applicants respectfully submit that all of the pending claims are allowable over the art of record, and ask that the Examiner withdraw the Rejection entered in the case and allow the application to issue. However, if there are any remaining issues the Examiner is encouraged to call Applicant's attorney, Jeffrey H. Canfield at (312) 807-4233 in order to facilitate a speedy disposition of the present case.

If any additional fees are required in connection with this response they may be charged to deposit account no. 02-1818.

Respectfully submitted,

BELL, BOYD & LLOYD LLC

BY

A handwritten signature in cursive script, appearing to read "Jeffrey H. Canfield", written over a horizontal line.

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